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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------|------------------|
| 09/753,863   | 01/03/2001  | Bruce D. Melick      | P04337US1                  | 1777             |
| 22885  | 7590        | 09/08/2005           |                            |                  |
| MCKEE, VOORHEES & SEASE, P.L.C.<br>801 GRAND AVENUE<br>SUITE 3200<br>DES MOINES, IA 50309-2721 |             |                      | EXAMINER<br>LE, THIEN MINH |                  |
|  |             |                      | ART UNIT                   | PAPER NUMBER     |
|  |             |                      | 2876                       |                  |

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

11.7

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/753,863 | <b>Applicant(s)</b><br>MELICK ET AL. |  |
|                              | <b>Examiner</b><br>Thien M. Le       | <b>Art Unit</b><br>2876              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21 and 23-36 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The amendment filed on 6/21/2005 has been entered. Claims 1-20, and 23 have been canceled. Claims 21-22 and 24-36 remain for examination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21 and 23-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durst et al. (Durst et al. – 5,933,829; herein after referred to as Durst; newly cited) in view of Bone, Jr. (Bone, Jr. –6,082,620; herein after referred to as Bone; newly cited).

Regarding claims 21, 26-27 and 36, Durst discloses a in figure 1 a document generation device 14 comprising: a data string 20, an encoder 28, text and graphics 16 and 18, and a printer 30 for printing a document 20 having a text 16, an image 18, and a 2D bar coder 12. Durst further shows in figure 1 a bar code scanner 34, a LAN 98, an Internet communication link 44, and an Internet server 46.

The claim differs in calling for the step of scanning the barcode from a display.

However, this claimed limitation is not new. Reference to Bone is cited as an evidence showing the conventionality of the claimed subject matter. Specifically, Bone discloses a LCD display 2 (figure 1) for displaying a barcode 4 and text 6 which can be scanned by a bar code scanner (see the descriptions of figure 1; col. 5 lines 1-10).

It would have been obvious to incorporate the teaching of scanning a bar code from a display in the manner as taught Bone in the system as taught by Durst. The modification allows the bar code to be scanned without printing bar code and thus would reduce overall system cost while allowing the bar code to be stored electronically for subsequence usages.

Regarding claims 23, 30-31, see the discussions regarding claim 21. The examiner considers the first software is the software for generating the bar code

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and text as shown in box 14 of figure of Durst, as has been modified by Bone in order to display the bar code for scanning. Further, the combined system of Durst/Bone comprises other software: i.e., the Internet server software, the scanner software, etc. (see figure 1 of Durst). Since this claim is merely a broad recitation of a second software, the examiner is of the view that any other software as discussed above would embrace the claimed limitation set forth in these claims.

Regarding claims 25, 29, see the discussions regarding claim 21. As to the claimed high scan rate scanner, the examiner is of the view the Durst/Bone system is applicable for all types of hand-held scanners, portable scanners, stylus, and thus would embrace at least some types of high scan rate scanners. Thus, the use of a high scan rate scanner is merely the indented application of Durst/Bone system.

Regarding claim 28, the claimed limitation is merely subjective which is considered as the intended application of the system as taught by Durst/Bone, as has been discussed in claim 21 above.

Regarding claims 31-35, see the discussions regarding claims 21, and 23-30. The claims differ in calling for the method of displaying email messages, and or web-page. However, this claimed limitation is not new. Since the bar code can be stored electronically, the information could be attached, transmitted and/or display in email messages or web-pages. The examiner is of the view that the claimed limitations are merely the intended applications of the combined system as taught by Durst/Bone.

***Allowable Subject Matter***

Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claim 22 is objected to because the prior art fails to disclose the method of having a first software application which is executing on the computing device during the step of displaying while the step of using the information is using the information within a second software application executing on the computing device (note the same computing device).

**Remarks**

Applicant's arguments filed on 6/21/2005 have been considered but are moot in view of the new grounds of rejection.

Since applicant's amendment necessitate the new grounds of rejection. This Office Action has been made Final.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Le, Thien Minh**  
**Primary Examiner**  
**Art Unit 2876**  
**September 1, 2005**